

### **REMARKS**

Claims 1-75 were pending in the application. Claims 12-15, 28, 34, 35, 37-56, 58, 71 and 74 are cancelled, and claims 2-5, 8 16-18, 23-27, 30-33, 57, 68, 72 and 75 are amended. Claims 76 and 77 have been added. Claims 1-11, 16-27, 29-33, 36, 57, 59-70, 72, 73, and 75 therefore are pending and presented for review. Favorable reconsideration and allowance are requested in light of the foregoing amendments and the remarks which follow.

1. **Affirmation of Election**

The Examiner's acknowledgement of applicant's election of Invention I, species A (Figs. 1-5) claims 1-11, 16-27, 29-33, 36, 57, 59-70, 72, 73, and 75 is noted with appreciation. Non-elected claims 12-15, 28, 34, 35, 37-40, 42, 43, 46, 49-52, 54-56, 58, 71 and 74 have been canceled without disclaimer or prejudice as being drawn to nonelected invention. Likewise claims 41, 44, 45, 47, 48 and 53 have been canceled without disclaimer or prejudice as being drawn to nonelected species. Applicant notes that although claims 72, 73 and 75 were not included in the listing of claims presented in the December 2, 2004 communication, claims 72, 73 and 75 do fall within the elected invention and species and are still pending and presented for review.

2. **Clarifying Amendments to the Claims**

Claims 2, 17, 31-33, 68, 72, 73, and 75 have been amended to address a minor issues noted by the examiner. Applicant has incorporated the suggestions by the Examiner into these clarifying amendments.

**3. Rejection under 35 U.S.C. 112, second paragraph**

Claim 57 stand rejected under 35 U.S.C. §112, ¶2, as being indefinite. The Examiner contends that the claim includes method steps within an apparatus claim. Claim 57 has been amended to address these issues and remove the method steps. In light of the amendment, withdrawal of the rejection under 35 U.S.C. §112, ¶2 is therefore believed to be in order and is respectfully requested.

**4. Prior Art Rejections**

Claims 1, 3-5, 8, 9, 16-18, 23, 24, 27, 29-33, 36, 57, 59-70, 72, 73, and 75 are rejected under 35 USC 103(a) as being obvious over Herzog-Mesrobian et al. in view of Kato. Claims 2, 6, 7, 10, 11, 19-22, 25, and 26 are rejected under 35 USC 103(a) as being obvious over Herzog-Mesrobian et al. in view of Kato, and in further view of Gilbert. Applicants respectfully traverse this rejection because, *inter alia*, there is no teaching or suggestion to combine the Herzog-Mesrobian et al. patent with the Kato and Gilbert patents to produce an apparatus of the claimed type. Furthermore, even if the references were combined, the invention would not result. Therefore, reconsideration is in order and is respectfully requested.

**a. Traversal of Rejections**

Claim 1 recites an apparatus for containing a plant comprising a sleeve, a means for securing the sleeve to a vessel and a means for applying ornamentation to the sleeve. With respect to claim 1, the Examiner asserts that Herzog-Mesrobian discloses an apparatus for containing a plant comprising a sleeve and a means for securing the sleeve to the vessel. The

Examiner correctly notes that absent in Herzog-Mesrobian is a means for applying ornamentation to the sleeve. The Examiner incorrectly suggests that Kato discloses “a means for applying ornamentation to a floral sleeve.” To the contrary, Kato is clearly directed to applying ornamentation of a floral pot, not a sleeve. Despite this key difference, the Examiner further suggests that the combination of the elements disclosed Herzog-Mesrobian and Kato would have been obvious to one of ordinary skill in the art at the time. This rejection is improper because there is no motivation to combine the prior art to produce the claimed invention. The Examiner’s statement to the contrary appears to be nothing more than supposition based on an improper hindsight reconstruction of applicants’ own device.

Herzog-Mesrobian is directed at cover sleeves for flower pots, specifically the adaptability to multiple pot sizes, aesthetics, and functionality advantages thereof. However, there is no suggestion within Herzog-Mesrobian to combine additional ornamentation with these sleeves. Similarly, Kato is directed at positioning ornamentation directly on a ceramic flower pot. It describes a displaying means, but the means are limited by an illustrative list; printing, coating, pasting, engraving, and relief specifically configured for application to a pot. This disclosure is strictly directed to applying ornamentation directly to a flower pot and there is no suggestion or teaching within Kato to place the ornamentation onto a sleeve to be placed over the flower pot. Furthermore, even if there was some motivation to combine these references, many of Kato’s disclosed displaying means would not work on the claimed sleeve. For example, pasting ornamentation as taught in Kato to an elastic sleeve will likely result in an impermanent

bond. As the sleeve expands and contracts the paste or glue bond would likely weaken and eventually the ornamentation would fall.

The cited Gilbert patent cannot cure these deficiencies. Gilbert discloses a floral container that is formed from receptacle-forming panels joined together to form a receptacle for a flower bouquet or other plants wherein one or more panels are removably joined to one of the receptacle-forming panels so that it may be selectively removed from the receptacle. Gilbert discloses that the removable panel may include indicia corresponding to such events as a special holiday. However, there is no disclosure of applying the indicia directly to a sleeve.

Clearly, none of the cited references teach or suggest applying ornamentation to a sleeve, and as such one of ordinary skill in the art would not have been motivated to take the teachings of Kato and Gilbert and apply them to a sleeve. To conclude otherwise would be to pick and choose amongst the teachings of the prior art, using applicant's own disclosure as a template or mosaic to latch on to those teachings that support the Examiner's position while ignoring those that do not. The Federal Circuit has held that a rejection based on obviousness cannot be predicated upon such an approach:

It is impossible with the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of the other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

*In re Hedges*, 228 USPQ 685, 687 (Fed. Cir. 1986), citing *In re Wesslau*, 3147 USPQ 391, 393 (CCPA) 1965; *see also* MPEP § 2143.

For at least these reasons, the references alone or in combination fail to teach or suggest the apparatus of claim 1.

Dependent claims 2-11, 16-27, 29-33, 36, 57, 59-70, 72, 73, and are believed to be in condition for allowance for incorporating by reference the limitations of claim 1 and for defining additional features of the invention, which when considered in combination with those of claim 1 are not disclosed by the prior art relied upon in the rejection.

Furthermore, claims 3-5, 8, 16-18, 23, 24, 27, 30, 31, 32, 33, 36, 57, 59-70, 72, 73, 75 as amended now depend either directly or indirectly from new claims 76 and 77. Claim 76 recites an apparatus, wherein the means for applying the ornamentation is stitching the ornamentation to the sleeve. Claim 77 recites an apparatus, wherein the means for applying the ornamentation is by placing another layer over the sleeve.

Specifically, claim 30, dependant from claim 77, is related to an ornamentation not contemplated by Kato. For example, beads are not disclosed by Kato as possible ornamentation and therefore it is believed that Kato is an inappropriate reference in determining a rejection of claim 30 based on obvious. For this reason, in addition to those stated above, it is believed that claim 30 is allowable.

Neither Herzog-Mesrobian, Kato or Gilbert alone or in combination disclose either stitching the ornamentation to the sleeve or placing another layer over the sleeve. It would be physically impossible to stitch ornamentation onto the ceramic flower pot of Kato or the pot of

Gilbert. Similarly there is no disclosure in any of these references to apply the ornamentation by placing another layer over the sleeve.

#### **5. New Claims and Conclusions**

As noted above, newly presented dependent claims 76 and 77 are believed to be in condition for allowance for incorporating by reference the limitations of claim 1 and for defining additional features of the invention, which, when considered in combination with those of claim 1, are not anticipated by the prior art relied upon in the rejection.

New claim 76 is dependant from claim 1 and requires that the ornamentation be applied to the sleeve by stitching. On page 6, line 25 and 26 other means for applying ornamentation to the sleeve are disclosed. Specifically, page 7 lines 15-17 disclose stitching as a means of applying an object to the sleeve.

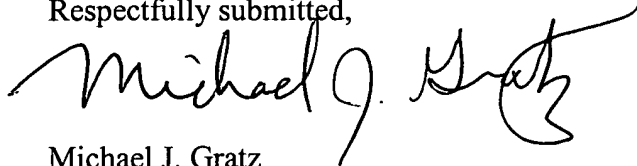
New claim 77 is dependant from claim 1 and requires that the ornamentation be applied to the sleeve by adding another layer on top of the first sleeve. On page 5, line 29 the specification discloses an embodiment of a multi-layered sleeve.

For the forgoing reasons, claims 1-11, 16-27, 29-33, 36, 57, 59-70, 72, 73, and 75 are believed to be in *prima facie* condition for allowance. Should the Examiner have any remaining questions that the attending to of which would expedite such action, he is invited to contact the undersigned at the telephone number appearing below.

U.S. Serial No. 10/649,490 - Herzog-Mesrobian et al.  
Art Unit 3643 - Attorney Docket 773.003  
Response to February 24, 2005 Office Action  
Page 14 of 14

Enclosed is a check for \$60 in payment of the government filing fee by a *small* entity for a one-month extension of time, which applicant hereby requests. No additional fee is believed to be payable with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Respectfully submitted,



Michael J. Gratz  
Registration No. 39,693

Date: June 24, 2005

BOYLE FREDRICKSON NEWHOLM  
STEIN & GRATZ S.C.  
250 Plaza, Suite 1030  
250 East Wisconsin Avenue  
Milwaukee, WI 53202  
Telephone: (414) 225-9755  
Facsimile: (414) 225-9753

The PTO did not receive the following  
listed item(s) A check for \$60.00

Customer No. 23598